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10/084,153	02/28/2002	Christiane Foertsch	32860-000278/US	4915

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EXAMINER

JONES, HUGH M

ART UNIT PAPER NUMBER

2128

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/084,153	FOERTSCH ET AL.	
	Examiner	Art Unit	
	Hugh Jones	2128	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-26 of U. S. Application 10/084,153, filed 02/28/2002, are pending.

#### **Claim Interpretation**

2. It is interpreted that limitations such as those recited in claims 17-20 recite examples of intended use and therefore are not accorded patentable weight. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).
3. It is noted that the claims are replete with language such as "can be entered", "which can be set". In these cases, the recitations following such phrases are not required by the claims. Furthermore, no patentable weight is given to such recitations, as they are not required by the claims.

#### **Claim Rejections - 35 USC § 101**

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. ***Claims 1-24 are rejected under 35 U.S.C. 101 because the claimed invention***

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***is drawn to non-statutory subject matter because the claims are drawn to nonfunctional descriptive material.***

*Per claims 1-20: The Examiner submits that claims 1-20 as written, are merely drawn to nonstatutory descriptive material since the claimed program does not impart any functionality. (i.e. not a computer program product or executable instructions embodied on a computer-readable medium).*

6. *MPEP 2106 recites the following supporting rational for this reasoning:*

*"Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data. **Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se.** Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is **recorded on some computer-readable medium** it becomes structurally and **functionally interrelated to the medium** and will be **statutory in most cases since use of technology permits the function of the descriptive material to be realized.**"*

7. *In this case, applicants have merely claimed computer (program) code that is not embodied on a computer-readable medium and specifically employed as a computer component to be executed on a processor and perform the claimed limitations. Thus, Applicants have attempted to claim nonfunctional descriptive material.*

*Per claims 21-24, merely nonfunctional descriptive material, stored in a computer, does not make it statutory.*

8. **Therefore, Claims 21-24 are rejected under 35 U.S.C. 101 because the claims recite a computer program product.** It should be noted that code (i.e., a computer software program) does not do anything per se. Instead, it is the code stored on a

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computer that, *when executed*, instructs the computer to perform various functions. The following claim is a generic example of a proper computer program product claim;

*A computer program product embodied on a computer-readable medium and comprising code that, when executed, causes a computer to perform the following:*

*Function A*

*Function B*

*Function C, etc...*

9. ***Claims 1-24 are rejected under 35 U.S.C. 101*** because the claimed invention is directed to non-statutory subject matter, because the claims lack practical application.

10. *Applicant's have merely claimed a manipulation of abstract ideas.*

*Per claims 1-24: The Examiner submits that the claims as written, are merely drawn to an abstract algorithm for creating subsets of data.*

11. An invention which is eligible for patenting under 35 U.S.C. 101 is in the useful arts when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. *The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “useful, concrete and tangible result.”* The test for practical application as applied by the examiner involves the determination of the following factors:

(1) Useful - The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying

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utility case law the examiner will note that:

(a) the utility need not be expressly recited in the claims, rather it may be inferred.

(b) if the utility is not asserted in the written description, then it must be well established.

Furthermore, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(2) Tangible - Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium which enabled its functionality to be realized.

(3) Concrete - Another consideration is whether the invention produces a concrete result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

12. The Examiner respectfully submits, under current PTO practice, that the claimed invention does not recite a *concrete, useful and tangible result*. The claims appear to be

reciting abstract algorithmic steps.

13. In practical terms, claims define nonstatutory processes if they consist solely of mathematical operations without some claimed practical application (i.e., executing a “mathematical algorithm”); or simply manipulate abstract ideas, e.g., a bid (Schrader, 22 F.3d at 293-94, 30 USPQ2d at 1458-59) or a bubble hierarchy (Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759), without some claimed practical application. Cf. Alappat, 33 F.3d at 1543 n.19, 31 USPQ2d at 1556 n.19 in which the Federal Circuit recognized the confusion: The Supreme Court has not been clear . . . as to whether such subject matter is excluded from the scope of 101 because it represents laws of nature, natural phenomena, or abstract ideas. See Diehr, 450 U.S. at 186 (viewed mathematical algorithm as a law of nature); Gottschalk v. Benson, 409 U.S. 63, 71-72 (1972) (treated mathematical algorithm as an “idea”). The Supreme Court also has not been clear as to exactly what kind of mathematical subject matter may not be patented. The Supreme Court has used, among others, the terms “mathematical algorithm,” “mathematical formula,” and “mathematical equation” to describe types of mathematical subject matter not entitled to patent protection standing alone. The Supreme Court has not set forth, however, any consistent or clear explanation of what it intended by such terms or how these terms are related, if at all.

14. A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical

application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan (discussed in i) below), or (B) be limited to a practical application within the technological arts (discussed in ii) below). See *Diamond v. Diehr*, 450 U.S. at 183-84, 209 USPQ at 6 (quoting *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1877)) ("A [statutory] process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.... The process requires that certain things should be done with certain substances, and in a certain order, but the tools to be used in doing this may be of secondary consequence."). See also *Alappat*, 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond v. Diehr*, 450 U.S. at 192, 209 USPQ at 10). See also *id.* at 1569, 31 USPQ2d at 1578-79 (Newman, J., concurring) ("unpatentability of the principle does not defeat patentability of its practical applications") (citing *O'Reilly v. Morse*, 56 U.S. (15 How.) at 114-19). If a physical transformation occurs outside the computer, a disclosure that permits a skilled artisan to practice the claimed invention, i.e., to put it to a practical use, is sufficient. On the other hand, it is necessary for the claimed invention taken as a whole to produce a practical application if there is only a transformation of signals or data inside a computer or if a process merely manipulates concepts or converts one set of numbers into another.

15. The claims merely recite forming subsets of abstract numbers ("data"). It is noted that the claims are replete with language such as "can be entered", "which can be set". In these cases, the recitations following such phrases are not required by the claims. Consider claim 1, for example. Nothing is actually done with the disembodied software.



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There is no transformation of matter and no practical application. There is no concrete, useful and tangible result.

**Claim Rejections - 35 USC § 102**

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

17. Claims 1-26 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Gilpin et al..

18. Gilpan et al. disclose :

1) A computer-aided configuration tool, into which a number of technical elements and their technical relationships can be entered, such that the elements and their relationships specify a technical system (abstract), comprising:

technical characteristics which can be set for each element in the configuration tool, wherein only the setting of technical characteristics for a first element is permissible, on the basis of which it remains compatible with a second element with which it is intended to be related (Fig. 2-3; col. 1, lines 54-60; col. 2, lines 1-23; col. 5, line 49 to col. 6, line 21; col. 8, lines 1-10).

2) A computer-aided configuration tool, into which a number of technical elements and their technical relationships can be entered, such that the elements and their relationships specify a technical system (abstract), comprising:

technical characteristics which can be set for each element in the configuration tool, wherein the characteristics of a first and of a second element and a relationship which exists between these elements, are used to check whether the first element is compatible with the second element (Fig. 2-3; col. 1, lines 54-60; col. 2, lines 1-23; col. 5, line 49 to col. 6, line 21; col. 8, lines 1-10).

3) The configuration tool as claimed in claim 2, wherein the elements, their technical characteristics and their relationships are read from at least one of a file and a file system (fig. 1).

4) The configuration tool of claim 3, wherein the file is an ASCII file (fig. 1).

5) The configuration tool as claimed in claim 1, wherein the elements, their technical characteristics and their relationships are at least one of interactively enterable and amendable (fig. 3, # 302; col. 4, lines 8-62; col. 5, lines 49-55).

6) The configuration tool as claimed in claim 2, wherein the elements, their technical characteristics and their relationships are at least one of interactively enterable and amendable (fig. 3, # 302; col. 4, lines 8-62; col. 5, lines 49-55).

7) The configuration tool as claimed in claim 3, wherein the elements, their technical characteristics and their relationships are at least one of interactively enterable and amendable (fig. 3, # 302; col. 4, lines 8-62; col. 5, lines 49-55).

8) The configuration tool as claimed in claim 5, wherein the technical characteristics for the elements are set by selecting one element from a catalog of elements with defined element-specific characteristics (col. 1, lines 24-40).

9) The configuration tool as claimed in claim 1, wherein the check for compatibility includes a check of the nature of the first and of the second element, a check of the existing relationship and a check as to whether the first element satisfies a technical condition which is dependent on at least one of the nature of the second element and of the existing relationship (col. 5, line 49 to col. 6, line 59).

10) The configuration tool as claimed in claim 9, wherein the condition can be selected from a set of conditions which are stored in at least one of a file and a file system (Fig. 3B-3D).

11) The configuration too of claim 10, wherein the file is an ASCII file (fig. 1).

12) The configuration tool as claimed in claim 2, wherein the check for compatibility includes a check of the nature of the first and of the second element, a check of the existing relationship and a check as to whether the first element satisfies a technical condition which is dependent on at least one of the nature of the second element and of the existing relationship (col. 5, line 49 to col. 6, line 59).

13) The configuration tool as claimed in claim 12, wherein the condition can be selected from a set of conditions which are stored in at least one of a file and a file system (Fig. 3B-3D).

14) The configuration tool of claim 13, wherein the file is an ASCII file (Fig. 1).

15) The configuration tool as claimed in claim 5, wherein the entered or amended elements, their technical characteristics and their relationships can be stored as at least one of a file and a file system (Fig. 1).

16) The configuration tool of claim 15, wherein the file is an ASCII file (Fig. 1).

17) The configuration tool as claimed in claim 1, wherein the elements are electrical elements, and the characteristics are at least one of electrical, electronic and electromechanical characteristics (intended use – col. 5, lines 2-44).

18) The configuration tool as claimed in claim 2, wherein the elements are electrical elements, and the characteristics are at least one of electrical, electronic and electromechanical characteristics (intended use – col. 5, lines 2-44).

19) The configuration tool as claimed in claim 17, wherein the elements are low voltage switching devices and their upstream and downstream elements (intended use – col. 5, lines 2-44).

20) The configuration tool as claimed in claim 18, wherein the elements are low voltage switching devices and their upstream and downstream elements (intended use – col. 5, lines 2-44).

21) The configuration tool of claim 1, embodied in a memory (Fig. 1).

22) The configuration tool of claim 1, embodied in a computer readable medium (Fig. 1).

23) The configuration tool of claim 2, embodied in a memory (Fig. 1).

24) The configuration tool of claim 2, embodied in a computer readable medium (Fig. 1).

25) An apparatus comprising:

a memory for storing a computer aided configuration tool including technical characteristics which can be set for each element in the configuration tool, wherein only the setting of technical characteristics for a first element is permissible, on the basis of which it remains compatible with a second element with which it is intended to be related; and input means for permitting at least one of entry and change of at least one of an element, a technical characteristic, and element relationships (Fig. 2-3; col. 1, lines 54-60; col. 2, lines 1-23; col. 5, line 49 to col. 6, line 21; col. 8, lines 1-10).

26) An apparatus comprising:

a memory for storing a computer aided configuration tool including technical characteristics which can be set for each element in the configuration tool, wherein the characteristics of a first element and of a second element and a relationship that exists between these elements, are used to check whether the first element is compatible with the second element (Fig. 2-3; col. 1, lines 54-60; col. 2, lines 1-23; col. 5, line 49 to col. 6, line 59; col. 8, lines 1-10); and

input means for permitting at least one of entry and change of at least one of an element, a technical characteristic, and element relationships (Fig. 1; fig. 3 # 302).

**Response to Arguments**

19. Applicant's arguments, filed 2/2/2006, have been carefully considered but are not persuasive.

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20. Applicants are thanked for the amendment to the figures. The objection is withdrawn.

21. The objection to the claims is withdrawn in view of Applicant's arguments.

Applicants state, third paragraph, page 12 of the response, that:

"...the configuration tool is embodied in a memory or in a computer readable device."

22. It is noted that the claims never recited a formal statutory class, such as, for example, apparatus, method or system. In the office action of 8/2/2005, it was assumed from a plain reading of the claims, that claims 1 and 2 and therefore all dependent claims, were either apparatus or system claims; hence the concern about mixing statutory classes. However, Applicants have stated that claims 1 and 2 refer to computer programs. Therefore, claims 21-24 do further limit the claims, as argued by Applicants.

23. Note the new 101 rejections, based upon Applicant's admissions (third paragraph, page 12 of the response). See MPEP 2145 [R-2] (Consideration of Applicant's Rebuttal Arguments), which states that,

**"I. ARGUMENT DOES NOT REPLACE EVIDENCE WHERE EVIDENCE IS NECESSARY**  
**Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection.** See MPEP § 2129 and § 2144.03 for a discussion of admissions as prior art. The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) ("An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness."). See MPEP § 716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration."

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24. Applicant's arguments against the 102 rejections are only based upon swearing back behind the applied reference. This is ineffective for reasons subsequently presented. Applicants have made no other arguments.

25. The Declaration filed on 2/2/2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the applied reference for the following reasons:

*Regarding applicant's Declaration: Applicant's appear to be attempting to swear behind the prior art references used in the 35 USC 102(e) rejection by filing a declaration establishing an earlier invention. However, the declaration (under 37 CFR 1.131) filed 2/2/2006 is insufficient to overcome the rejection of claims as set forth in the last Office action because it is not properly executed and fails to establish reduction to practice prior to the date of the reference. Applicant has therefore not shown prior invention and the rejection is maintained. However, in the interest of expediting prosecution, the Examiner will provide some guidance as to perceived deficiencies in the submitted declaration. These comments are not meant to be comprehensive.*

*- Applicant's declaration is not comprehensive: Applicant's declaration has merely alleged conception at least prior to the date of the applied reference as evidenced by the "written disclosure of the invention" but has not met the burden of establishing satisfactory evidence of the facts. In this case, each exhibit has not been specifically referred to in the declaration in terms of what it relied upon to show in establishing due diligence.*

26. MPEP 715.07 recites the following:

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**"THREE WAYS TO SHOW PRIOR INVENTION"**

The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP § 715.07(c)), at least the conception being at a date prior to the effective date of the reference. **Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR 1.131).**

As discussed above, 37 CFR 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show:

(A) reduction to practice of the invention prior to the effective date of the reference; or

(B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or

(C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

**A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT,** such as an actual reduction to practice or filing an application for a patent.

*Automatic Weighing Mach. Co. v. Pneumatic Scale Corp.*, 166 F.2d 288, 1909 C.D. 498, 139 O.G. 991 (1st Cir. 1909).

**Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.**

**27. Reduction to Practice**

*- Applicant's declaration amounts to mere pleading: Applicants declaration merely alleges that the inventor completed reduction to practice, but again, applicants have not met burden establishing satisfactory evidence of the facts. That is, the specific "means themselves and their interaction" for the claimed subject matter has not been demonstrated. Proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose or that a method was actually practiced. What must be shown to have been*



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*reduced to practice is something that falls within the scope of the claimed invention. "For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose..." (King Instruments, MPEP 2138.05), (a) did not clearly explain how the exhibits establish conception and/or reduction to practice of the claimed invention.*

MPEP 715.07 further recites the following:

**"715.07 [R-2] Facts and Documentary Evidence**

**I. GENERAL REQUIREMENTS**

*The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration.*

**Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show.** *For example, the allegations of fact might be supported by submitting as evidence one or more of the following:*

- (A) attached sketches;*
- (B) attached blueprints;*
- (C) attached photographs;*
- (D) attached reproductions of notebook entries;*
- (E) an accompanying model;*
- (F) attached supporting statements by witnesses, where verbal disclosures are the evidence relied upon. Ex parte Ovshinsky, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989);*
- (G) testimony given in an interference. Where interference testimony is used, the applicant must point out which parts of the testimony are being relied on; examiners cannot be expected to search the entire interference record for the evidence. Ex parte Homan, 1905 C.D. 288 (Comm'r Pat. 1905);*
- (H) Disclosure documents (MPEP § 1706) may be used as documentary evidence of conception.*

*Exhibits and models must comply with the requirements of 37 CFR 1.91 to be entered into an application file. See also MPEP § 715.07(d).*

**A general allegation that the invention was completed prior to the date of the reference is not sufficient.** *Ex parte Saunders, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883).*

*Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131."*

28. In a nutshell, it cannot be established from the declaration which of the techniques described in the written disclosure of the invention, applicants are attempting

*to rely on for demonstrating reduction to practice in the completion of the claimed subject matter.*

29. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the reference to either a constructive reduction to practice or an actual reduction to practice.

30. As stated in MPEP 715.07(a) (Diligence):

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence. In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958). What is meant by diligence is brought out in *Christie v. Seybold*, 1893 C.D. 515, 64 O.G. 1650 (6th Cir. 1893). In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity; the USPTO or courts will not speculate on possible explanations for delay or inactivity. See *In re Nelson*, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970). Diligence must be judged on the basis of the particular facts in each case. See MPEP § 2138.06 for a detailed discussion of the

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diligence requirement for proving prior invention. Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" is not relevant to an affidavit or declaration under 37 CFR 1.131.

Ex parte Merz, 75 USPQ 296 (Bd. App. 1947).

31. *The examiner therefore maintains the 102 rejections.*

32. *However, a properly structured and documented declaration specifically addressing the issues outlined above may be effective in swearing behind the referenced prior art.*

33. Applicant's comments pertaining to the claim interpretation are noted and are not persuasive. Applicant's arguments based on 112(2) are not relevant. A 112(2) rejection has not been applied. A claim may recite features that have no patentable weight without necessarily causing 112 issues.

34. It is noted that limitations such as those recited in claims 17-20 recite examples of intended use and therefore are not accorded patentable weight. *A recitation of the intended use of the claimed invention **must result in a structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. **If the prior art structure is capable of performing the intended use, then it meets the claim.*** In a claim drawn to a process of making, the

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intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

35. It is noted that the claims are replete with language such as "can be entered", "which can be set". In these cases, the recitations following such phrases are not required by the claims. Furthermore, no patentable weight is given to such recitations, as they are not required by the claims.

### **Conclusion**

36. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

37. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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**38. Any inquiry concerning this communication or earlier communications from the examiner should be:**

directed to: Dr. Hugh Jones telephone number (571) 272-3781,

Monday-Thursday 0830 to 0700 ET,

**or**

the examiner's supervisor, Kamini Shah, telephone number (571) 272-2279.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, telephone number (703) 305-3900.

**mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-9051 (for formal communications intended for entry)

**or** (703) 308-1396 (for informal or draft communications, please label *PROPOSED* or *DRAFT*).

Dr. Hugh Jones

Primary Patent Examiner

March 24, 2006

HUGH JONES Ph.D.  
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TECHNOLOGY CENTER 2100